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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte TAKESHI FUNAKI and YURIKO TAKASE

Appeal 2015-008255
Application 12/937,411
Technology Center 1700

Before JEFFREY T. SMITH, KAREN M. HASTINGS,
and MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF CASE

Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision to finally reject claims 1–12 and 14–28. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

Claim 1 illustrates the subject matter on appeal and is reproduced below:

> 1. A film comprising
>
> (i) a resin obtained by copolymerizing polyvinyl alcohol and at least one or more polymerizable vinyl monomers; and
>
> (ii) a drug or a food component,
>
> wherein the thickness of the film is 0.1 to1000 μm, and
>
> wherein the amount of the resin is 40 to 85% by weight relative to the total weight of the film.

Appellants (App. Br. 3) request review of the following rejections from the Examiner's Non-Final Office Action of September 26, 2014:

I. Claims 1–12, 14–18, and 20–28 are rejected under 35 U.S.C. § 103(a) as unpatentable over Noami (US 2006/0229383 A1, published October 12, 2006) and Hoshi (US 6,967,026 B2, issued November 22, 2005).

II. Claims 19, 23, and 26 are rejected under 35 U.S.C. § 103(a) as unpatentable over Noami, Hoshi and Kajiyama (US 7,074,428 B2, issued July 11, 2006).

III. Claims 1–12, 14–18, 20–22, 24, 25, 27 and 28 are rejected under 35 U.S.C. § 103(a) as unpatentable over Noami, Hoshi and Bone (US 7,083,047 B2, issued August 1, 2006).

IV. Claims 19, 23, and 26 are rejected under 35 U.S.C. § 103(a) as unpatentable over Noami, Hoshi, Bone and Kajiyama.

OPINION[1]

After review of the respective positions provided by Appellants and the Examiner, we REVERSE the Examiner's prior art rejections of claims 1–12 and 14–28 under 35 U.S.C. § 103(a) (Rejections I–IV) for the reasons presented by Appellants and add the following for emphasis.

Independent claim 1 is directed to a film comprising a polyvinyl alcohol based resin component and a drug or a food component, where the amount of the resin is 40 to 85% by weight relative to the total weight of the film.

We refer to the Examiner's Non-Final Action for a statement of the rejection. Non-Final Act. 2–4.

Appellants argue Noami and Hoshi do not disclose a film having the claimed amount of resin of 40 to 85% by weight relative to the total weight of the film. App.Br. 4, 5, 7. Appellants further argue that the proportion of 20 to 95 wt% mentioned by Hoshi, and relied upon by the Examiner to meet the claimed amount of resin, clearly refers to the amount of the PVA and/or derivative thereof *in the PVA copolymer* (emphasis added). App. Br. 6–7; Hoshi col. 3, ll. 54–61. That is, Appellants argue Hoshi does not disclose the amount of PVA copolymer resin to be from 20–95 % by weight. App. Br. 7.

We agree with Appellants. The Examiner found Noami teaches a film comprising a PVA copolymer component and a food component (sucrose)

[1] All prior art rejections are based on the combined teachings of Noami and Hoshi. *See* Non-Final Action, *generally*. We limit our discussion to the rejection of claim 1, as presented in Rejection I, with the understanding that it also applies to Rejections II–IV.

but does not disclose the claimed amount of PVA copolymer in the film. Non-Final Act. 2–3; Noami ¶¶ 3, 7, 8, 24, 29, 64–70 (Examples 4, 5), 74–77 (Example 7). The Examiner relies on Hoshi's disclosure of a coating film comprising PVA at weight percentages of 20 to 95 wt% or 50 to 90 wt% for providing a higher degree of solubility properties, avoiding the risk of the ability of the capsule to dissolve. Non-Final Act. 3; Hoshi col. 3, ll. 5–68, col. 4, ll.1–5. However, as noted by Appellants, the weight percentages in Hoshi refer to the amount of the PVA and/or derivative thereof in the PVA copolymer and not the amount of PVA copolymer itself. App. Br. 6–7. The Examiner has directed us to no portion of Hoshi that discloses a film having a PVA *copolymer* component in the amount of 40 to 85% by weight relative to the total weight of the film (emphasis added). Thus, the Examiner has not adequately explained why one skilled in the art would have modified the resin component of Noami's film by increasing it to the amounts claimed. The Examiner has not adequately shown how one skilled in the art would have modified Noami's film based on Hoshi's disclosure to arrive at the claimed invention.

Under these circumstances, we cannot conclude that the Examiner has met the minimum threshold of establishing obviousness under 35 U.S.C. § 103(a). *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Accordingly, we reverse the Examiner's prior art rejections of claims 1–12 and 14–28 under 35 U.S.C. § 103(a) for the reasons presented by Appellants and given above.

ORDER

The Examiner's prior art rejections of claims 1–12 and 14–28 are reversed.

REVERSED